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EDWARD S. WRIGHT 1100 ALMA STREET SUITE 207 MENLO PARK, CA 94025			HUYNH, LOUIS K	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/087,897

Filing Date: March 01, 2002

Appellant(s): PERKINS ET AL.

MAILED

JUL 14 2004

GROUP 3700

Edward S. Wright
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 08, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

None.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-7 and 13-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,423,166	SIMHAE	07-2002
4,936,079	SKALSKY et al.	06-1990
4,017,351	LARSON et al.	04-1977
5,581,983	MURAKAMI	12-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 7, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky (US 4,936,079). This rejection is set forth in a prior Office Action, mailed on January 15, 2004.

Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky (US 4,936,079) as applied to claims 1 and 4 above; and further in view of Larson et al. (US 4,017,351). This rejection is set forth in a prior Office Action, mailed on January 15, 2004.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky (US 4,936,079); and further in view of Larson et al. (US 4,017,351). This rejection is set forth in a prior Office Action, mailed on January 15, 2004.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky (US 4,936,079) as applied to claim 4 above; and further in view of Murakami (US 5,581,983). This rejection is set forth in a prior Office Action, mailed on January 15, 2004.

(11) Response to Argument

(A) In response to appellant's argument with respect to Claims 1, 4 and 7 that there is no motivation or basis other than appellant's own disclosure and claims for combining the teachings of Simhaee and Skalsky in the manner suggested by the examiner, that the rejection is a clear example of impermissible hindsight reconstruction, and that the applied references (Simhaee and Skalsky) are not analogous art as stated in the Brief spanning from page 3, last paragraph to page 4, line 5; the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)); furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper (see *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)); moreover, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention (see *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)).

In this case, the Simhaee reference discloses a method and a machine for making air-filled packing cushions that meets all of appellant's claimed subject matter but lacks the specific

teaching of a pair of spaced apart, horizontally extending rollers on which the roll of film material rests. The Skalsky reference teaches in the Summary of the Invention at column 1, lines 58-68 that the roll support assembly including a pair of spaced apart parallel rollers of the invention is to permit the easy replacement of the roll of material. Such teaching has reasonably provided the motivation for combining the roll support assembly of Skalsky for supporting the roll of material in the machine of Simhaee so that depleting roll of film material can be replaced with a new roll of film material easily in a relatively short down time of the machine. The Simhaee and the Skalsky references are in the same field of endeavor because they are both concerned with packaging wherein a web of material is fed through a packaging machine and thus the Skalsky reference is highly relevant to a skilled person in the art in solving the problem of supporting and replenishing film material that is fed into a packaging machine.

Appellant further argues that Claims 1, 4 and 7 distinguish over the prior art in specifying that the roll of film material rests on the rollers *above* the inflation tube, that the inflation tube *extends in an upward direction*, and that the material is fed in a generally *downward direction* from the roll to the inflation tube. Appellant argues that such structural relationship is neither found in nor suggested by the applied references. However, the combination of the Simhaee and Skalsky references has met the claimed subject matter as claimed in Claims 1, 4 and 7 except for the specific arrangement of the machine elements. The Simhaee reference discloses in Figure 5 a schematic of the machine with the spatial relationship of the machine elements which is applicable to a machine having machine elements being arranged either vertically or horizontally. For example, it would have been obvious to the skilled person in the art to have visualized a horizontally arranged machine with the roll of material positioned on one side of the

machine when viewing the page of the schematic sideway or a vertically arranged with the roll of material positioned at the top of the machine when viewing the page of the schematic upside down. Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have arranged the modified machine of Simhaee with the roll of material positioned at the top for dispensing the material downwardly from the roll to the inflation tube according to the schematic of Figure 5.

For the above reasons, it is believed that the rejection of Claims 1, 4 and 7 should be sustained.

(B) In response to appellant's argument with respect to Claims 2, 3, 5 and 6 that the combination of Simhaee and Skalsky further in view of Larson reference (US 4,017,351) does not suggest the use of a stainless steel heating element and a wheel in a machine having the other features of appellant's invention, the Larson reference teaches a machine and a method for making air-filled cushioning material wherein a stainless steel belt 44 being heated and in cooperation with a wheel 40 for sealing the inlet openings 20 of the film material 12. Such teaching is well known in the art, and therefore, is obvious to a skilled person in the art to have applied such teaching in the modified machine of Simhaee. With respect to the limitation of the heating element comprising a stainless steel rod as recited in Claims 3 and 6, the prior art of record does not show such feature; however, the specific shape of the heating element is obvious as a matter of engineering design choice since it does not offer to solve any particular problem relating to sealing the inlet passageways, and the stainless steel belt of Larson when combined with the modified machine of Simhaee seems to work equally well.

For the above reasons, it is believed that the rejection of Claims 2, 3, 5 and 6 should be sustained.

(C) In response to appellant's argument with respect to Claims 16, 17, 19 and 20 that none of the applied references teaches that the inflation channel of the film material being pinched closed by one of the rollers as stated in the Brief on page 5, lines 17- 25. In rejecting Claims 4 and 7, a *prima-facie* of obviousness has been reasonably set forth and thus a valid combination of the references (Simhaee in view of Skalsky) has been clearly set forth in the prior Office Action, mailed January 15, 2004. As such, the modified machine of Simhaee would have the roll support assembly of Skalsky which includes a pair of spaced apart parallel rollers for supporting the roll of material and one of the rollers would have pinched the inflation tube of the film material due to the weight of the roll of material. With respect to the film material being drawn directly from a nip formed between the one of the support roller or around the roll of material after leaving the nip would have been obvious to a skilled person in the art as a matter of engineering design choice to have placed the roll of material in either position since the placement of the roll of material on the support rollers does not offer to solve any stated problem and the modified machine of Simhaee would have worked equally well with the roll of film material being placed on the support rollers in either position.

For the above reasons, it is believed that the rejection of Claims 16, 17, 19 and 20 should be sustained.

(D) In response to appellant's argument with respect to Claim 18 that the claim is directed to patentable subject matter of Claim 4 and further specifies: "the air injector comprises an inflation tube which extends into the inflation channel, and the means for feeding the film

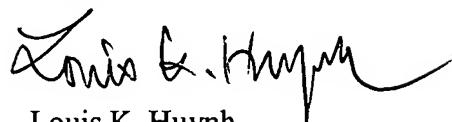
material from the roll includes dual feed rollers positioned on opposite sides of the inflation tube for engagement with the film material on opposite sides of the inflation channel,” the rejection of Claim 4 has been reasonably set forth in the prior Office Action , mailed January 15, 2004, and discussed in the *Response to Argument*, paragraph (A) above, and the rejection of Claim 18 has been reasonably set forth in the prior Office Action , mailed January 15, 2004.

For the above reasons, it is believed that the rejection of Claim 18 should be sustained.

(E) In response to appellant’s argument with respect to Claims 13-15 that the claims distinguish over the combined teaching of Simhaee, Skalsky and Larson in calling for a cabinet adapted to rest on a relatively small horizontal supporting surface and that the pair of spaced apart horizontally extending rollers are on the upper side of the cabinet for receiving the roll of film material, the claimed subject matter of Claim 13 can be found in Claim 1 or 4, the rejection of Claim 13 has been reasonably set forth in the prior Office Action, mailed January 15, 2004, and discussed with respect to Claims 1 and 4 in the *Response to Argument*, paragraph (A) above. The claimed subject matter of Claims 14 and 15 can be found in Claims 2 and 3, the rejection of Claims 14 and 15 has been reasonably set forth in the prior Office Action, mailed January 15, 2004, and discussed with respect to Claims 2 and 3 in the *Response to Argument*, paragraph (B) above.

For the above reasons, it is believed that the rejection of Claims 13-15 should be sustained.

Respectfully submitted,



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July 9, 2004

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